

Application # PCT/US04/23280

Attorney Docket # 1043-004

IN THE INTERNATIONAL BUREAU OF WIPO

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : de Janasz
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For : Vehicle-Based Wireless Identification System

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STATEMENT UNDER ARTICLE 19(1)

In accord with PCT Article 19, Applicant respectfully submits the following statement in response to the International Search Report and Written Opinion mailed on 14 June 2005.

Statement

The Examiner is respectfully thanked for the thoughtful consideration provided to this application. Reconsideration of this application is respectfully requested in light of the following statements.

Claims 1-33 are now pending in this application. Each of claims 1, 14, and 15 are in independent form.

Novelty

PCT Article 33(2) states that “a claimed invention shall be considered novel if it is not anticipated by the prior art as defined in the Regulations.”

A. Claims 1-5, 7-12, and 14

The Written Opinion contends that each of claims 1-5, 7-12, and 14 lacks novelty under PCT Article 33(2) as being anticipated by Swett (US 5,101,200). These contentions are respectfully traversed.

Swett allegedly recites the “light display on the face of the FLCC indicates to the driver that the FLCC **batteries** are fully charged. If the Power-On light does not illuminate, then the driver knows that the **batteries** are low and, as a result, the driver moves out of the fast lane into one of the stop and pay lanes.” *See* col. 21, lines 19-24.

Each of independent claims 1 and 14 recite “a **vehicle-powered** non-telephonic wireless transmitter”. Swett does not expressly or inherently teach or recite “a **vehicle-powered** non-telephonic wireless transmitter”.

Thus, Swett does not anticipate independent claims 1 and 14. Accordingly, it is respectfully submitted that the contentions regarding claims 1 and 14 are unsupported by Swett and should be withdrawn. Also, each of claims 2-5 and 7-12, each ultimately depending from independent claim 1, is unsupported by Swett and also should be withdrawn.

Consequently, Applicant respectfully submits that each of claims 1-5, 7-12, and 14 meets the requirements of Article 33(2) PCT, and Applicant respectfully requests notification thereof.

B. Claims 15-20, 25-28, 30, and 32-33

The Written Opinion contends that each of claims 15-20, 25-28, 30, and 32-33 lacks novelty under PCT Article 33(2) as being anticipated by Banerjee (US Patent Publication 2003/0020634). These contentions are respectfully traversed.

Banerjee allegedly recites the “basic components of tag 302 may be fabricated using ‘coil-on-chip’ technology. Analogue circuitry 401 provides for data transfer and power supply”. See Paragraph 0028. One skilled in the art would instantly recognize that RFID tags, such as those allegedly recited in Banerjee, either generate power internally or obtain power from an internal battery.

Independent claim 14 recites “a **vehicle-powered** non-telephonic wireless transmitter”. Banerjee does not expressly or inherently teach or recite “a **vehicle-powered** non-telephonic wireless transmitter”.

Thus, Banerjee does not anticipate independent claim 15. Accordingly, it is respectfully submitted that the contention that claim 15 lacks novelty is unsupported by Banerjee and should be withdrawn. Also, each contention that claims 16-20, 25-28, 30 lack novelty, and 32-33, each ultimately depending from independent claim 15, is unsupported by Banerjee and also should be withdrawn.

Moreover, regarding certain other rejected claims:

1. claim 25 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if a counter-party to the proposed transaction is a predetermined restricted counter-party”;
2. claim 26 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if a subject matter of the proposed transaction is a predetermined restricted subject matter”;
3. claim 27 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if a time of the proposed transaction is a predetermined restricted time”; and
4. claim 28 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if a date of the proposed transaction is a predetermined restricted date.”

Consequently, Applicant respectfully submits that each of claims 15-20, 25-28, 30, and 32-33 meets the requirements of Article 33(2) PCT, and Applicant respectfully requests notification thereof.

Inventive Step

PCT Article 33(3) states that “a claimed invention shall be considered to involve an inventive step if, having regard to the prior art as defined in the Regulations, it is not, at the prescribed relevant date, obvious to a person skilled in the art.”

A. Claim 6

The Written Opinion contends that claim 6 lacks an inventive step under PCT Article 33(3) as being obvious over Swett in view of Rhodes (US 5,770,999). This contention is respectfully traversed.

As discussed above, Swett does not anticipate independent claim 1.

Independent claim 1 recites “a vehicle-powered non-telephonic wireless **transmitter**”. Rhodes does not mention any **transmitter** whatsoever. Instead, Rhodes allegedly recites an “improved blackout control system located within the passenger compartment allows the driver to alter the normal and emergency lighting features of the vehicle.” *See* Abstract.

By contrast, Swett allegedly recites a portable “Fast Lane Credit Card”, which “[d]rivers in the fast lane place the small Fast Lane Credit Card on the dashboard in front of the steering wheel, and turn on the Power-On switch of the FLCC.” *See* col. 21, lines 13-16. Swett allegedly recites the “light display on the face of the FLCC indicates to the driver that the FLCC **batteries** are fully charged. If the Power-On light does not illuminate, then the driver knows that the **batteries** are low and, as a result, the driver moves out of the fast lane into one of the stop and pay lanes.” *See* col. 21, lines 19-24.

Thus, the “FLCC” of Swett is already equipped with a power supply and a power-on switch. Why would one skilled in the art look to Rhodes for either a redundant power supply or a redundant switch for the “FLCC”? Moreover, why would one skilled in the

art desire to require a user to actuate “a manually activated high beam switch” (*see* Rhodes col. 4, line 15) activate a transmitter in Swett each time a user passes a “fast lane activity monitor” (*see* Fig. 4 of Swett) instead of automatically transmitting a signal from the “FLCC” as recited in Swett?

In fact, Swett allegedly recites “electronic security measures which apprehend would-be toll evaders if they attempt to get by moving-traffic toll lanes without paying. This allows the state or turnpike authority to apprehend and prosecute all would-be toll evaders.” *See* col. 6, lines 58-63. Thus, one skilled in the art would recognize that as a result of the proffered combination of Swett with Rhodes, a driver forgetting to actuate “a manually activated high beam switch” would be apprehended, which would frustrate the purpose of Swett. Moreover, Swett teaches away from manual activation by stating that “[o]f course, the photograph of the dashboard, and license plate, is used as evidence against would-be toll evaders if a person did not use his/her FLCC, but claims he/she did. The fact of an empty dashboard is the evidence.” *See* col. 21, lines 40-44. Thus, Swett relies on continuous **automatic** transmission (as opposed to Rhodes “manually activated high beam switch”) from the “FLCC” since mere presence of the “FLCC” on a dashboard is “evidence against would-be toll evaders if a person did not use his/her FLCC, but claims he/she did.”

No evidence is presented in the Written Opinion that indicates a suggestion or motivation for combining Rhodes with Swett. Accordingly, one skilled in the art would not combine Rhodes with Swett. Thus, no *prima facie* case of lack of inventive step has been established. Consequently, Applicant respectfully submits that claim 6 meets the requirements of Article 33(3) PCT, and Applicant respectfully requests notification thereof.

B. Claim 13

The Written Opinion contends that claim 13 lacks an inventive step under PCT Article 33(3) as being obvious over Swett in view of Scott (US 6,484,260). This contention is respectfully traversed.

As discussed above, Swett does not anticipate independent claim 1.

Scott allegedly recites that “[e]ach registered person uses a **battery powered**, portable personal identification device (PID) 6, which communicates with a communication unit 8 located at each host facility 4.” *See* col. 6, lines 34-37.

Independent claims 1 recites “**a vehicle-powered non-telephonic wireless transmitter**”. Scott does not expressly or inherently teach or recite “a vehicle-powered non-telephonic wireless transmitter”. Thus, Scott does not cure the deficiencies of Swett.

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest **every** limitation of the independent claims, and consequently fail to establish a *prima facie* case of lack of inventive step.

Consequently, Applicant respectfully submits that claim 6 meets the requirements of Article 33(3) PCT, and Applicant respectfully requests notification thereof.

C. Claims 21-24 and 31

The Written Opinion contends that each of claims 21-24 and 31 lack an inventive step under PCT Article 33(3) as being obvious over Banerjee in view of Hassett (US 5,805,082). These contentions are respectfully traversed.

As stated above, Banerjee does not anticipate independent claim 15.

Hassett allegedly recites “power supply elements preferably include a **compact, user-replaceable long-life battery** 74, such as a lithium power cell. These elements can also include an on/off switch incorporating a battery check position.” *See* col. 16, lines 10-14.

Hassett does not cure the deficiencies of **Banerjee**.

Moreover, regarding certain other rejected claims:

1. claim 23 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if the

proposed transaction exceeds a predetermined amount for a predetermined counter-party”; and

2. claim 24 recites, yet Banerjee does not expressly or inherently teach or disclose, “transmitting a rejection of the proposed transaction if the proposed transaction exceeds a predetermined amount for a predetermined time interval for a predetermined counter-party.”

Thus, even if there were motivation or suggestion to modify or combine the cited references (an assumption with which the applicant disagrees), and even if there were a reasonable expectation of success in combining or modify the cited references (another assumption with which the applicant disagrees), the cited references still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of lack of inventive step.

Consequently, Applicant respectfully submits that each of claims 21-24 and 31 meets the requirements of Article 33(3) PCT, and Applicant respectfully requests notification thereof.

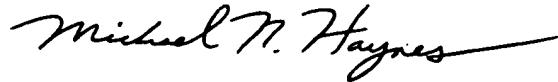
CONCLUSION

It is respectfully submitted that, in view of the foregoing statements, the application is in clear condition for a favorable International Preliminary Examination Report.

Reconsideration, withdrawal of all grounds of contention, and issuance of a favorable International Preliminary Examination Report are earnestly solicited.

The Examiner is invited to contact the undersigned at 434-972-9567 to discuss any matter regarding this application.

Respectfully submitted,

A handwritten signature in black ink, reading "Michael N. Haynes", with a long horizontal flourish extending to the right.

Date: 14 Sep 2005

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